

REMARKS

Entry of the foregoing, reexamination and reconsideration of the subject application are respectfully requested in light of the amendments above and the comments which follow.

As correctly noted in the Office Action Summary, claims 15-30 were pending. By the present response, claims 15-19, 21-23 and 25-30 have been amended, claim 20 canceled, and claims 31-45 have been added. Thus, upon entry of the present response, claims 15-19 and 21-45 remain pending and await further consideration on the merits.

Support for the foregoing amendments can be found, for example, in at least the following locations in the original disclosure: page 3, lines 2-3; page 5, lines 30-31; page 10, lines 33-35; and the original claims.

CLAIM OBJECTIONS

Claims 16, 19, 20 and 27 are objected to because of informalities. Claims 16, 19, 20 and 27 have been amended to address the formal objections. Thus, reconsideration and withdrawal of the claim objections is respectfully requested.

CLAIM REJECTIONS UNDER 35 U.S.C. §112

Claims 19, 21-23 and 26-20 stand rejected under 35 U.S.C. §112, second paragraph, on the grounds set forth on page 2 of the Official Action.

By the present response, applicants have amended the claims, without narrowing the scope thereof, in a manner which addresses the above-noted

rejection. Therefore, reconsideration and withdrawal of the rejection is respectfully requested.

CLAIM REJECTIONS UNDER 35 U.S.C. §101

Claims 26-30 stand rejected under 35 U.S.C. §101 on the grounds set forth on page 4 of the Official Action. For at least the reasons noted below, this rejection should be withdrawn.

The grounds for rejection are erroneously based upon the assertion that claims 26-30 are directed to a "use" of the precipitated silica of claim 15. This is incorrect. Claims 26 to 30 are directed to articles of manufacture, they are not method claims. These claims do not recite any "use" or method steps whatsoever. Thus, the grounds for rejection are unfounded and should be withdrawn.

OBVIOUSNESS-TYPE DOUBLE PATENTING

Claim 25 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 28, 42, 58 and 49 of copending U.S. Patent Application No. 10/500,107 on the grounds set forth on pages 5-7 of the Official Action.

The requirements for making out a *prima facie* case of obviousness-type double patenting is summarized, for example, in MPEP §804:

[T]he analysis employed in an obviousness-type double patenting rejection parallels the guidelines for analysis of a 35 U.S.C. 103 obviousness determination. *In re Braat*, 937 F.2d 589, 19 USPQ2d 1289 (Fed. Cir. 1991); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985).

Since the analysis employed in an obviousness-type double patenting determination parallels the guidelines for a 35 U.S.C. 103(a) rejection, the factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148

USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103 are employed when making an obvious-type double patenting analysis. These factual inquiries are summarized as follows:

- (A) Determine the scope and content of a patent claim relative to a claim in the application at issue;
- (B) Determine the differences between the scope and content of the patent claim as determined in (A) and the claim in the application at issue;
- (C) Determine the level of ordinary skill in the pertinent art; and
- (D) Evaluate any objective indicia of nonobviousness.

The conclusion of obviousness-type double patenting is made in light of these factual determinations.

Any obviousness-type double patenting rejection should make clear:

- (A) The differences between the inventions defined by the conflicting claims - a claim in the patent compared to a claim in the application; and
- (B) The reasons why a person of ordinary skill in the art would conclude that the invention defined in the claim at issue >is anticipated by, or would have been an obvious variation of, the invention defined in a claim in the patent.

When considering whether the invention defined in a claim of an application would have been an obvious variation of the invention defined in the claim of a patent, the disclosure of the patent may not be used as prior art. *General Foods Corp. v. Studiengesellschaft Kohle mbH*, 972 F.2d 1272, 1279, 23 USPQ2d 1839, 1846 (Fed. Cir. 1992).

When considered in light of these requirements, the obviousness-type double patenting rejection set forth on pages 5-7 of the Official Action fails to make out a *prima facie* case.

For example, claim 25 of the present application is a dependent claim, depending from claim 15. The grounds for rejection fail to even address any of the limitations appearing in claim 15.

In addition, claim 25 of the present application contains the limitation: "wherein the filtration cake exhibits, prior to the drying of it in stage (f), a loss on ignition at 1000°C of greater than 82%." The grounds for rejection also failed to even address this additional difference.

Thus, for at least for the reasons explained above, the grounds for rejection are deficient and should be withdrawn.

CLAIM REJECTIONS UNDER 35 U.S.C. §§102/103

Claims 15-30 stands rejected under 35 U.S.C. §102(b) as being anticipated by or, in the alternative, under 35 U.S.C. §103(a) as obvious WO 01/93803 A2 to Chevallier et al. (using U.S. Patent No. 7,033,576 B2 as an English translation) (hereafter "Chevallier et al.") on the grounds set forth on page 8 of the Official Action. For at least the reasons noted below, this rejection should be withdrawn.

The present invention is directed to precipitated silica characterized by low water uptake, and a process for preparation of the same. Conventional precipitated silica generally exhibit a high affinity for water molecules due to the presence of Si-OH groups on the surface thereof. According to the present invention, a precipitated silica is provided possessing a unique combination of properties, including a low water uptake, which render it especially suitable for certain applications.

A precipitated silica formulated according to the principles of the present invention as set forth in claim 15. Claim 15 recites:

15. *A precipitated silica comprising:*
a CTAB specific surface of 140 to 230 m²/g,
a DOP oil uptake of greater than 300 ml/100 g,
a water uptake of less than 6%,
a pH of 3.5 to 7.5,
a level of residual anion, expressed as sodium sulfate, of less than or equal to 2%, and
a mean particle size or a median particle diameter of less than 30 μm.

Chevallier et al., which is commonly owned by the assignee of the present application, neither anticipates nor renders obvious the precipitated silica of claim 15.

Chevallier et al. is directed to precipitated silica useful as a thickening or texturing agent. As admitted on page 11 of the Official Action, Chevallier et al. fails to disclose a precipitated silica having the claimed low water uptake properties required by claim 15. Nevertheless, it is asserted that it would have been "obvious to one of ordinary skill in the art at the time of the invention to have expected the silica of Chevallier et al. to have a water uptake similar to that of the instant invention . . ." This assertion is respectfully traversed.

The grounds for rejection appear to confuse, or improperly combine, the two distinct concepts of inherency and obviousness. A determination of obviousness cannot be supported upon a finding of inherency alone. This is because that which is inherent is not necessarily known. Obviousness cannot be predicated upon that which is unknown. *In re Spormann*, 150 USPQ 449, 452 (C.C.P.A. 1966). Moreover, It is improper to rely upon inherency has some form of substitute for a teaching or suggestion supporting an assertion of obviousness. *In re Newell*, 13 USPQ2d 1248, 1250 (Fed. Cir. 1989) ("[A] retrospective view of inherency is not a substitute for some teaching or suggestion which supports the selection and use of the various elements in the particular claim combination").

When assertions are made based upon features that are not expressly disclosed in the prior art, the Federal Circuit has repeatedly stated that in order to establish the inherency of the missing element it must be shown that the missing element must necessarily be present in the reference, and would be recognized as such by those persons of ordinary skill in the art. *Continental Can Co. USA v. Monsanto Co.*, 948 F.2d 1264, 20 USPQ2d 1746, 1749-50 (Fed. Cir. 1991); *In re Oelrich*, 666 F.2d 578,581, 212 USPQ 323, 326 (C.C.P.A. 1981) ("inherency,

however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient"); *Standard Oil Co. v. Montedison, S.p.A.*, 664 F.2d 356, 372, 212 USPQ 327, 341 (3d Cir. 1981) (for a claim to be inherent in the prior art it "is not sufficient that a person following the disclosure sometimes obtain the result set forth in the [claim]; it must invariably happen").

The structure implied by process steps should be considered when assessing patentability where the manufacturing process steps would be expected to impart distinctive structural characteristics to the final product. *In re Garnero*, 412 F.2d 276, 279, 162 USPQ 221, 223 (CCPA 1979).

As previously noted, precipitated silicas have a natural tendency to attract water. Thus, it is improper to assume that precipitated silica would inherently possess a low water uptake as required by the present claimed invention. In addition, contrary to the assertion contained in the Official Action, the precipitated silicas of the present invention are prepared by a distinct process. For example, the process for producing the precipitated silica of the present invention utilizes a filter cake having a higher admission loss at 1000°C than that described by Chevallier et al. Given the well-recognized correlation between the method of preparing a precipitated silica, and its resulting morphological properties, it would not be expected that the precipitated silica of Chevallier et al. would inherently possess the low water uptake characteristic of the presently claimed invention.

Thus, reconsideration and withdrawal of the rejection is respectfully requested.

The remaining claims depend from claim 15. Thus, these claims are also distinguishable over Chevallier et al. for at least the same reasons noted above.

Moreover, as mentioned above, Chevallier et al. also fails to disclose, or even suggest, the process recited by claim 25, including the use of the filter cake which possesses a greater ignition loss at 1000°C than that described by Chevallier et al.

With respect to claims 26-30, the grounds for rejection erroneously assert that these claims are directed to a "use of the silica." This is incorrect. Claims 26-30 are clearly directed to articles of manufacture. Thus, it is improper to couch the rejection of these claims as intended uses of the silica of the present claimed invention.

Thus, the dependent claims are also distinct over Chevallier et al. for at least these additional reasons

Claims 15-30 stands rejected under 35 U.S.C. §102(e) as being anticipated by or, in the alternative, under 35 U.S.C. §103(a) as obvious WO 03/055801 A1 to Valero et al. (using U.S. Patent Application Publication No. 2005/0074386) (hereafter "Valero et al.") on the grounds set forth on page 16 of the Official Action. For at least the reasons noted below, this rejection should be withdrawn.

Is unclear from the grounds for rejection whether WO 03/055801 or US2005/0074386 are being applied against the claims of the present application.

In either case, the rejection is improper because neither reference qualifies as prior art under 35 U.S.C. §102(e) against the present claimed invention.

WO 03/055801 was never published in English. Thus, this reference cannot be applied under 35 U.S.C. §102(e), and the international filing date cannot be relied upon as a U.S. filing date for purposes of 35 USC 102(e). See, MPEP 706.02 (f)(1).

US2005/0074386 has a 35 U.S.C. §102(e) reference date (the date of completion of the requirements under 35 U.S.C. §371 (c) (1), (2), and (4)) of June 25, 2004. However, the present application claims priority pursuant to 35 U.S.C. §119 to two French priority applications, namely, FR 0315063 (filed December 19, 2003) and FR 0403700 (filed April 8, 2004). As set forth in MPEP 706.02(b), a rejection under 35 U.S.C. §102(e) can be overcome by a perfected priority claim pursuant to 35 U.S.C. §119. As indicated in the Office Action Summary, certified copies of these priority documents have been received from the International Bureau. Thus, Valero et al. does not qualify as prior art pursuant to 35 U.S.C. §102(e). If it is deemed necessary, applicants can provide a certified English translation of these priority documents.

CONCLUSION

From the foregoing, further and favorable action in the form of a Notice of Allowance is earnestly solicited. Should the Examiner feel that any issues remain, it is requested that the undersigned be contacted so that any such issues may be adequately addressed and prosecution of the instant application expedited.

Respectfully submitted,

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